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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,689	12/05/2001	Danny E. Potter	1348-1011	4681

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,689

Applicant(s)

POTTER, DANNY E.

Examiner

Gerald Gauthier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-59,61-68 and 70-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-59,61-68 and 70-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/14/2004 has been entered.

Claim Objections

2. **Claim(s) 84** is objected to because of the following informalities: line 2 "the storage medium" is repeated twice. Correction is required.

Claim(s) Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim(s) 33-34, 38-42, 46-51, 55, 57-58, 66-67 and 75-76** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto (US 4,850,005) in view of Barber et al. (US 5,251,251) and in further view of Fisch et al. (4,949,085).

Regarding **claim(s) 33 and 41**, Hashimoto discloses a method of operating a telephone answering device connected to a telephone line (column 1, lines 7-9), the method comprising:

answering an incoming call from a calling party on the telephone line (FIG. 6 and column 5, lines 32-45) [The telephone answering device FIG. 1 answers the incoming call when the calling signal is detected];

playing a general outgoing message to the calling party on the telephone line (FIG. 6 and column 5, lines 32-45) [The telephone answering device FIG. 1 plays the outgoing message for general calling party to identify the caller]; and

providing options to the calling party including adding an incoming message received from the calling party on the telephone line to the storage location and replacing the message stored in the storage location with the incoming message from the calling party received on the telephone line (FIG. 6 and column 6, lines 18-33) [The telephone answering device FIG. 1 allows the calling party to leave a message if the calling party voice is not recognized].

Hashimoto discloses the caller voices his name and determines the code associated with the messages but fails to disclose responsive to receipt on the telephone line of a code from the calling party, playing to the calling party on the telephone line a message stored in a storage location.

However, Barber teaches responsive to receipt on the telephone line of a code from the calling party, playing to the calling party on the telephone line a message stored in a storage location (column 4, lines 28-32) [The recipient calls the facility and

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enters the access code to hear the subscriber's personalized voice message stored in the memory unit 300].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Hashimoto using the access code as taught by Barber.

This modification of the Hashimoto's invention would offer the capability of hearing a personalized voice message from the subscriber so that the recipient would hear its name in the personalized message.

Hashimoto discloses the caller leaving a message for the subscriber but fails to disclose replacing the message stored in the storage location with the incoming message from the calling party received on the telephone line.

However, Fisch teaches replacing the message stored in the storage location with the incoming message from the calling party received on the telephone line (FIG. 8 and column 12, lines 56-61) [The systems allow the incoming message to be recorded in the slot of the message].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Hashimoto using the system of saving memory as taught by Fisch.

This modification of the Hashimoto's invention would offer the capability of replacing the message stored by the incoming message so that the recipient would hear the unread messages.

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Regarding **claim(s) 34, 42 and 51**, Hashimoto discloses responsive to expiration of a predetermined period of time without receipt on the telephone line of the code from the calling party, recording an incoming message from the calling party received on the telephone line in an incoming message storage location (column 6, lines 11-25).

Regarding **claim(s) 38 and 46**, Hashimoto discloses the storage location further comprises a plurality of storage locations and wherein the code is associated with one storage location of the plurality of storage locations (column 6, lines 3-17).

Regarding **claim(s) 39, 47 and 50**, Hashimoto discloses subsequent to playing a general outgoing message to the calling party on the telephone line, playing a tone to the calling party on the telephone line if the message has been stored in the storage location (column 3, lines 24-37).

Regarding **claim(s) 40, 48 and 55**, Hashimoto discloses the code comprises at least one dual-tone multi-frequency tone (column 7, lines 8-23).

Regarding **claim(s) 49**, Hashimoto, Barber and Fisch disclose all the limitations of **claim(s) 49** as stated above in **claim(s) 33's** rejection and further more discloses a line monitoring circuit as a control circuit (1 on FIG. 1a) connecting to telephone lines L1 and L2 (L1 and L2 on FIG. 1a) and a dynamic access memory (RAM-1 on FIG. 1b)

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used as a storage to store a general outgoing message and specific messages for callers (column 2, lines 31-41).

Regarding **claim(s) 57 and 66**, Hashimoto, Barber and Fisch disclose all the limitations of **claim(s) 57 and 66** as stated in **claim(s) 33'** s rejection.

Regarding **claim(s) 58 and 67**, Hashimoto discloses responsive to expiration of a predetermined period of time without receipt on the telephone line of the code, recording an incoming message from-the calling party received on the telephone line (column 6, lines 11-25).

Regarding **claim(s) 75**, Hashimoto, Barber and Fisch disclose all the limitations of **claim(s) 75** as stated above in **claim(s) 57's** rejection and further more discloses a line monitoring circuit as a control circuit (1 on FIG. 1a) connecting to telephone lines L1 and L2 (L1 and L2 on FIG. 1a) and a dynamic access memory (RAM-1 on FIG. 1b) used as a storage to store a general outgoing message and specific messages for callers (column 2, lines 31-41).

Regarding **claim(s) 76**, Hashimoto discloses the control circuit causes a special tone to be played to the calling party subsequent to playing the general outgoing message to the calling party if the message thread is stored on the storage medium (column 3, lines 24-37).

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5. **Claim(s) 35-37, 43-45, 52-54 and 57-83** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Barber, in view of Fisch and in further view of Miner et al. (US 6,021,181).

Regarding **claim(s) 35-36, 43-44, 52-53, 59 and 68**, Hashimoto, Barber and Fisch as applied to **claim(s) 33, 41, 49, 57 and 66** differ from **claim(s) 35-36, 43-44, 52-53, 59 and 68** in that it fails to disclose defining a message thread with the message stored in the storage location and the incoming message from the calling party received on the telephone line.

However, Miner teaches defining a message thread with the message stored in the storage location and the incoming message from the calling party received on the telephone line (column 14, lines 52-63).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Hashimoto using the defining a message thread with the message stored as taught by Miner.

This modification of the Hashimoto's invention would offer the capability of defining a message thread with the message stored so that the recipient would hear its name in the personalized message.

Regarding **claim(s) 37, 45 and 54**, Miner teaches the step of providing options further comprises the option of deleting the message stored in the storage location (column 10, lines 33-41).

Regarding **claim(s) 61 and 70**, Miner teaches the message thread further comprises a sequence of messages (column 10, lines 20-31).

Regarding **claim(s)s 62-65, 71-74, 77 and 79-83**, Miner teaches at least one of the messages in the sequence of messages has been replaced (column 14, lines 34-51).

6. **Claim(s) 56 and 84** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto in view of Barber, in view of Fisch and in further view of Bates et al. (US 6,741,680).

Regarding **claim(s) 56 and 84**, Hashimoto, Barber and Fisch as applied to **claim(s) 49 and 75** above differ from **claim(s) 56 and 84** in that it fails to disclose a group consists of a random access memory, a magnetic tape and digital storage media.

However, Bates teaches the storage medium is selected from the group consisting of random access memory, magnetic tape and digital storage media (column 9, lines 1-9).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Hashimoto using the storage medium as taught by Bates.

This modification of the Hashimoto's invention would offer the capability of the saving the messages different ways so that the subscriber would listen to its messages.

Response to Arguments

7. Applicant's arguments with respect to **claim(s)s 33-84** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GERALD GAUTHIER
PATENT EXAMINER

g.g.

February 1, 2005

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